



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/727,324

12/02/2003

Karl L. Ginter

7451.0005-04

6224

22852

7590

10/02/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

SHAN, APRIL YING

ART UNIT

PAPER NUMBER

2135

MAIL DATE

DELIVERY MODE

10/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/727,324	Applicant(s) GINTER ET AL.	
	Examiner APRIL Y. SHAN	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-59, 62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) 42-59, 62 and 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicant's amendment, filed 07 July 2008, has been received, entered into the record, and respectfully and carefully considered.
2. As a result of the amendment, claim 21 has been amended. Claims 1-20 and 60-61 are canceled. Claims 42-59 and 62-63 are withdrawn from consideration since they are non-elected claims. Claims 21-41 have been examined.
3. Any objection/rejection not repeated below is withdrawn due to Applicant's amendment/argument.

Priority

4. Applicant claimed the current application is a continuation-in-part of application No. 08/388,107 filed on Feb. 13, 1995, now abandoned.

The Examiner had reviewed carefully the parent application (08/388,107). The parent application (08/388,107) only discloses generally a digital certificate as "Other installations 600 may trust the "certificate"....". However, the examiner discovered at least three claim limitations, receiving a first digital certificate from a user, the first digital certificate attesting to at least one attribute of the user, determining, based at least in part on the first digital certificate, whether the user is authorized to access the online service and if the user is determined by said determining step to be authorized to access the online service, issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service in the

Art Unit: 2135

independent claim 1 of the current application are not supported by the parent application (08/388,107).

The Applicant is respectfully reminded that the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 08/388,107, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Accordingly, claims 21-41 are not entitled to the filing date of the prior application (08/388,107).

The examiner further notes in this Office Action, an intervening reference (U.S. Pub. No. 2002/0144108) is presented to address Applicant's newly amended limitation in claim 21.

Information Disclosure Statement

5. The Applicant appreciates Applicant's good faith in submitting IDS dated November 23, 2005.

Therefore, **the below three references are considered** and these references do not appear relevant with the instant application.

- U.S. Patent No. 3,946,200 – Proportional Temperature Controller
- U.S. Patent No. 4,727,550 – Radiation Source
- U.S. Patent No. 5,227,797 – Radar Tomography

Claim Objections

6. Claims 24-25 are objected to because of the following informalities:

As per **claim 25**, "A method as in claim 24" is being recited. However, there is no claim 24 on page 3 of the claim. In order to further exam the merits on the claim, the examiner assumes the claim prior to claim 25, which has no claim number, is claim 24.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 2135

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
10. Claims 21-23, 26-27, 32-33 and 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) and in view of Benantar (U.S. Pub. No. 2002/0144108).

As per **claim 21**, Sudia discloses a method for providing access to an online service (“...electronic commerce business” – e.g. col. 4, lines 52-53), the method comprising:

receiving a first digital certificate from a user, the first digital certificate attesting to at least one attribute of the user (“receiving a digital identifying certificate issued by a certifying authority and have a plurality of digital fields, at least one of said 1fields identifying said user” – e.g. claim 1);

determining, based at least in part on the first digital certificate, whether the user is authorized to access the online service (“When a recipient user (verifier) receives a transaction 51 from a sending user, the recipient first uses the sender’s basic

Art Unit: 2135

key certificate 55 to verify the sender's signature 52 on the transaction..." – e.g. col. 9, lines 36-40); and

issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service ("receiving a digital authorization certificate, separate from said identifying certificate and issued by a sponsor of said user, and authorizing transactions by said user..." - e.g. claim 1, "...the recipient also uses the sender's authorization certificate 56, signed by the sender's sponsor 59, to verify..." – e.g. col. 9, lines 36-45).

Please note further in col. 14, lines 5-18, Sudia also discloses "...it may often be helpful to the copy the user's public key out of his basic authentication certificate and include it as another attribute in an authorization certificate. This permits the authorization certificate to serve both purposes (authentication and authorization) and allows the sender to omit the basic authentication certificate from each transaction". It is clear that in the Sudia reference, the authentication and authorization certificates are either two separate certificates or one authorization certificate to serve both authentication and authorization purposes.

Sudia does not explicitly disclose if the user is determined by said determining step to be authorized to access the online service.

However, Benantar discloses "*A common analogy using passports and visas has been widely disseminated to explain the differences between public key certificates and attribute certificates. A public key certificate can be analogized to a passport...In contrast, an attribute certificate can be analogized to a visa. A visa is used to gain*

Art Unit: 2135

access somewhere in a manner similar to using an attribute certificate to gain access to a system....Similarly, an attribute certificate must be accompanied by a public key certificate to verify/authenticate the identity of the user..." - e.g. [par. [0053] - [0054] and "...common steps, such as verifying the authenticity of a public key certificate...As another example, the attribute certificate authority may verify the identity of the user prior to issuing the attribute certificate..." – e.g. par. [0090].

Please further note Benantar's public key certificate corresponds to Sudia's digital identifying certificate and Benantar's attribute certificate corresponds to Sudia's a digital authorization certificate.

Sudia – Benantar are analogous art because they are from a similar field of endeavor in digital certificates. Thus, it would have been obvious to a person with ordinary skill in the art, at the time of invention, to modify the teachings of Sudia with verify the identity of the user prior to issuing the attribute certificate taught by Benantar since it is a common step in the field of digital certificate (e.g. Benantar, par. [0090]) to use the trusted relationships associated with digital certificates in order to authenticate user access to the systems (e.g. Benantar, par. [0090]).

As per **claims 22-23**, Sudia further discloses receiving a request from the user to access the online service ("...electronic commerce business" – e.g. col. 4, lines 52-53); checking the second digital certificate to determine whether the user has permission to access the online service ("verifying said transaction based on information in said identifying certificate and in said authorization certificate, said step of verifying including

Art Unit: 2135

applying said rules...to verify..." - e.g. claim 1); and allowing the user to access the online service if it is determined that the user has permission to access the online service ("accepting said transaction based on said outcome of said verifying..." - e.g. claim 1) and in which said checking step is performed in a protected processing environment at a local computer system from which the user made the request to access the online service ("a system for securely using digital signatures in a commercial cryptographic system..." – e.g. abstract).

As per **claims 26-27**, Sudia further discloses providing a third digital certificate to the user, the third digital certificate attesting to the identify of the online service, the third digital certificate being issued by a certifying authority (e.g. col. 3, lines 48-67, col. 4, lines 10-38) and in which the first digital certificate is issued by the certifying authority ("receiving a digital identifying certificate issued by a certifying authority and have a plurality of digital fields, at least one of said fields identifying said user" – e.g. claim 1).

As per **claim 32**, Sudia further discloses in which the second digital certificate attests to the user's permission to access the online service until a specified date ("Certificates also contain an expiration date..." – e.g. col. 4, lines 1-9).

As per **claim 33**, Sudia further discloses in which the at least one attribute comprises an indication of the amount of purchases the user is allowed to make in a given time period (e.g. col. 11, lines 11-41).

As per **claims 36-37**, Sudia further discloses in which the online service comprises a subscription (“...into the attribute certificates of the CA and its subscribers..” – e.g. col. 7, lines 37-38) and in which the second digital certificate includes an expiration date of the subscription (“Certificates also contain an expiration date...” – e.g. col. 4, lines 1-9).

As per **claims 38-39**, Sudia further discloses collecting payment information from the user (e.g. col. 12, lines 1-18) and further comprising: sending the payment information to a financial clearinghouse (e.g. col. 6, lines 1-15 and col. 12, lines 1-18).

As per **claims 40-41**, Sudia further discloses collecting information relating to the user's use of the online service (col. 12, lines 1-18) and further comprising sending the information relating to the user's use of the online service to a usage clearinghouse (e.g. col. 6, lines 1-15 and col. 12, lines 1-18).

11. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) – Benantar (U.S. Pub. No. 2002/0144108) and further in view of Arnold (U.S. Patent No. 5,956,408)

As per **claims 24-25**, Sudia – Benantar does not expressly disclose sending software to the user. However, this well known feature is disclosed in col. 1, lines 10-14

Art Unit: 2135

of Arnold reference. It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Arnold's sending software to the user with Sudia - Benantar since sending software to the user assures security (e.g. Arnold, col. 5, lines 1-14).

Arnold further discloses sending a digital signature for determining the integrity of the software to the user (Arnold, e.g. abstract) and in which the digital signature is bound, at least in part, to the identity of the online service (Arnold, e.g. abstract).

12. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) - Benantar (U.S. Pub. No. 2002/0144108) and further in view of Boulton et al. (U.S. Patent No. 5,537,618)

As per **claim 28**, Sudia – Benantar discloses a digital identifying certificate issued by a certifying authority and having a plurality of digital fields, at least one of said fields identifying said user (Sudia, e.g. claim 1 and Benantar, e.g. par. [0053]).

Sudia - Benantar does not expressly disclose in which the first digital certificate includes an indication of the user's age.

However, it is well known at the time of the invention age is an attribute to identify a user. This well known feature is disclosed in col. 37, lines 32-34 of the Boulton et al. reference.

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Boulton et al.'s age is an attribute to identity a user into Sudia - Benantar since a user's age is one of the attributes that identifying the user.

13. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) – Benantar (U.S. Pub. No. 2002/0144108) and further in view of examiner's official notice.

As per **claims 29-31**, Sudia - Benantar does not expressly disclose the first digital certificate identifies a party responsible for paying for the user's access to online service and sending a request for payment to the party responsible for paying for the user's access to online services; and receiving an indication that payment has been received and in which the steps of (a) sending a request for payment and (b) receiving an indication that payment has been received are performed prior to performing the step of sending the second digital certificate to the user. However, Sudia discloses for example in fig. 6 monetary limit and further in col. 12, lines 1-5, an online banking system is disclosed. The examiner takes official notice that the above missing well known features are common knowledge at the time of the invention. It would have been obvious to a person with ordinary skill in the art at the time of the invention to combine the common knowledge with Sudia - Benantar since they are well known in the art to produce predictable results.

Art Unit: 2135

14. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) – Benantar (U.S. Pub. No. 2002/0144108) and further in view of Rebane et al. (U.S. Patent No. 5,978,567)

As per **claims 34-35**, Sudia - Benantar does not expressly disclose in which the online service comprises an interactive online game.

However, this well known feature is disclosed in the abstract, col. 1, lines 48-64, col. 3, lines 22-31 and col. 8, line 66 – col. 9, line 12. It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Rebane et al.'s the online service comprises an interactive online game into Sudia - Benantar since online service comprises an interactive online game is offered electronically and interactively is well known in the art. (e.g. Rebane et al., col. 1, lines 48-64).

Sudia-Rebane et al. further discloses sending software for playing the online game to the user in a secure container (Sudia, - e.g. abstract and Rebane et al. - e.g. col. 9, lines 37-52).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO -892)

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2135

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2135
/KimYen Vu/

Supervisory Patent Examiner, Art Unit 2135